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A Unitary Patent for a (Dis)United Europe: The Long Shadow of History

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Abstract This article retraces the history of patent harmonization in Europe and reviews the European Union “patent package” and its approval by the Grand Chamber of the Court of Justice of the European Union in the light of this history. The article draws on archived and hitherto unused confidential documents to retrace the key institutions and players in the origins and evolution of the European patent unification movement. The study reveals that the EU project was originally led by the Council of Europe and analyzes the reasons why the EU has struggled to develop a coherent model of integration to facilitate realization of the internal market ever since. The historical legacy suggests that a critical turning point was the creation of the European Patent Organization as the leading engine of patent policy in Europe, an autonomous organization which is not subject to judicial oversight by the EU court or meaningful political scrutiny by the European Union and its members. The article concludes with a case study illustrating how the latent difficulties over the relationship between different European institutions and the jurisdiction of European tribunals and courts are manifested today in the unitary patent and the unified patent court.

Keywords Unitary patent · Unified Patent Court · European patent harmonization · Regulation (EU) No 1257/2012 · TFEU Art. 18 · TFEU Art. 291 · European Patent Organization

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1 Introduction

The international patent system is undergoing a profound transformation towards ever-greater global integration of institutions and harmonization of standards.¹ The movement for unification of the European patent system is part of this wider global trend, but the unification goal has proved difficult to realize in Europe notwithstanding persistent efforts dating back to the end of WWII. This paper draws on confidential archived documents to retrace the early origins and evolution of the European unification movement to examine what can be learnt from history. In line with recent historiographies of the synergies and rivalries between international organizations and the European community,² the paper reveals three phases in the evolution of norms and institutions in the unification movement in Europe. In the first phase, the European unification project is driven by the Council of Europe as part of an abstract ideal of European integration and is characterized by a “co-existence” model based on common denominators in national laws. In the second phase, the harmonization agenda is taken over by the European Community and its rationale morphed into the community’s goal of (dis)integration of national patent laws and their replacement by a uniform and autonomous patent community system as a strategic tool for the realization of the common market. But the EC’s initiative is frustrated and results instead in partial harmonization with the adoption of the European Patent Convention in 1973 and the creation of the European Patent Organization.³ This opens a third phase and problematic for the European community which is having to integrate a pivotal external institution into a unified legal architecture to serve the community’s goals. The last part of the paper illustrates with a case study how the shadow of the past has left its imprint in the disjointed and overly complex legal architecture of the latest patent unification initiative in the form of the EU “patent package”⁴ which was given the green light by the Grand Chamber of the Court of Justice of the European Union on 5 May 2015, and whose effect, it is argued, is to enlarge the role of the EPO whilst leaving the EPO outside the legal reach of the European Union.

¹ E.g. WIPO’s proposal for a Substantive Patent Law Treaty initiated in November 2000. For a critique see Reichman and Dreyfuss (2007); Maskus (2000); Drahos (2010).

² Patel (2013).

³ Convention on the Grant of European Patents (European Patent Convention) of 5 October 1973: <http://www.epo.org/law-practice/legal-texts/epc.html>. The EPO administers the Convention through the European Patent Office and the Administrative Council made up of representatives of member states (38 at the last count in January 2015): The Organisation currently has 38 member states, comprising all the Member States of the European Union together with Albania, Croatia, the former Yugoslav Republic of Macedonia, Iceland, Liechtenstein, Monaco, Norway, San Marino, Serbia, Switzerland and Turkey.

⁴ There have been numerous articles dissecting the many defects of the UPC, notably see Ullrich (2012); Hilty et al. (2012). The spectrum of alternative proposals ranges from abolition of national patent offices and jurisdiction of national courts to dismantlement of the EPC and full integration of the EPO into the European Union: Di Cataldo (2014); Van Pottelsberghe (2009).

2 In the Beginning: European Patent Integration Through Co-Existence

Efforts to unify industrial property rights go back to the end of the 19th century.⁵ The rapid expansion of industry and transport coupled with the liberal urge to remove barriers to trade led to proposals for a unified, global patent system and a proposal for a world patent as early as 1909:

... what was really wanted in order to meet the interest of industry, was the creation of a patent valid in more than a single country. All efforts to extend some of the effects of the national territorially limited patents to other countries would in the long run have to be considered as an insufficient patchwork. What was needed was a world patent, or at least a European patent.⁶

Detailed plans for the establishment of an international patent office which would have been charged with examining novelty were discussed at an international economic conference in Paris in 1916 and led to a resolution adopted in 1920.⁷ But the plan was not followed through as it did not secure the agreement of “the three leading inventive nations of the world”.⁸ After the Second World War, the work of the German Patent Office was temporarily halted. This left the patent offices of the UK and the Netherlands as the only patent offices in Europe with full searching services, prompting the creation of an International Patent Institute (BIRPI) with centralized searching facilities based in The Hague. It was anticipated that the Institute could evolve into an inter-European patent office. But in 1947, the priority was to deal with the backlog of patent applications held in national patent offices. So, the Institute’s function was limited to the technical examination of novelty whilst the grant of patents was still left to national offices in accordance with national laws.⁹

It was the Council of Europe which, two years later, provided the forum for the meetings which paved the way for closer integration of the European patent system. The vision of a unified patent system for Europe resonated with the grander post-war vision of a closer union¹⁰ between European States as the key to economic prosperity and peace in a divided and war-torn Europe.¹¹ In 1949, barely three months after its creation, the Council of Europe set in motion the movement towards unification of the European patent system which has yet to be fully realized today.¹² Retrospectively, the focus on integration of national patent systems from an

⁵ The outcome of these efforts was the adoption of the Paris Convention for the Protection of Industrial Property signed on 20 March 1883. See Von Holstein (1967).

⁶ *Op. cit.* 5. Von Holstein (1967) at 196.

⁷ Spencer (1959). Spencer explains that the Agreement was signed on 31 May 1921. France and Belgium were amongst the signatories, Germany was excluded by the Allied Powers and the US and the UK did not sign.

⁸ *Op. cit.* 7, at 1158.

⁹ *Op. cit.* 5, Von Holstein (1967) at 196.

¹⁰ Later described as “ever closer” in the Preamble of the Treaty of Rome 1957.

¹¹ On the history of the Council of Europe’s grand vision see Simpson (2004).

¹² COE. Doc., No 75, 3 September 1949.

organization which was poised to become the leading human rights organization in Europe is somewhat surprising. But, it reflects the scale of ambition of the abstract ideal of European integration¹³ captured in the founding Statute of the Council of Europe.¹⁴ Article 1(a) of the Statute proclaims the economic and social benefits of greater unity whilst Art. 1(b) expressly mandates the Council and its members¹⁵ to pursue this aim "... by agreements and common action in economic, social, cultural, scientific, legal and administrative matters and in the maintenance and further realisation of human rights and fundamental freedoms." The economic dimensions of the Council's mission were addressed by the Council of Europe's Committee for Economic Questions which identified patents alongside trade tariffs, agriculture, transport and postal services as areas of economic activity where integration could enhance economic prosperity.¹⁶ Yet, from the beginning, there was considerable divergence as to what integration precisely entailed and about the degree to which States would be required to surrender national sovereignty to achieve unity. This was particularly true of patent unification where the political, constitutional and national economic implications of dismantling the territorial legal structure of patents and replacing it with a centralized uniform European system were yet to be worked out.

The first proposal/Recommendation for the creation of a European Patent Office was endorsed by the consultative assembly of the Council of Europe at its first ordinary session on 8 September 1949.¹⁷ Under the proposed draft Convention of 1949,¹⁸ a European Patent Office would have been created and operated under the aegis of the Council of Europe and would have enjoyed the privileges and immunities reserved for officials of the organization.¹⁹ It would have been financed by the Council of Europe.²⁰ The EPO's function would have been primarily administrative – specifically to issue a "European Inventors Certificate" to inventors who would have applied for it through their respective national patents offices.²¹ Its main role would have been to ascertain the novelty of the invention²²

¹³ Described by some as "political messianism": Weiler (2012).

¹⁴ Adopted on 5 May 1949. On the extensive discussions which took place at the first session of the Council on how to foster economic growth, see Powell (1950).

¹⁵ The ten founding members of the Council of Europe were the Kingdom of Belgium, the Kingdom of Denmark, the French Republic, the Irish Republic, the Italian Republic, the Grand Duchy of Luxembourg, the Kingdom of the Netherlands, the Kingdom of Norway, the Kingdom of Sweden and the United Kingdom of Great Britain and Northern Ireland.

¹⁶ COE, Committee of Ministers Report to Parliamentary Assembly (1953) 4th session. Doc. 122, 7 May 1953.

¹⁷ The proposal was put forward by M.H. Longchambon on behalf of the Committee on Economic questions. Henri Longchambon, "Creation of a European Patents Office", Parliamentary Assembly of the Council of Europe, Committee on Economic Affairs and Development Report, 6 September 1949, COE Doc 75, Official Report No. 18.

¹⁸ COE, Doc 75 (1949) APPENDIX II to Report on the creation of a European Patents Office Study for draft Proposal of a Convention on the creation of a European Patent Office.

¹⁹ *Op. cit.* 18, Art. 6.

²⁰ *Op. cit.* 18, Arts. 7 and 8.

²¹ *Op. cit.* 18, Art. 1.

²² *Op. cit.* 18, Art. 2.

and its patentability in accordance with the legislation and precedents of Member States.²³ The European certificate would have enabled inventors to secure national patents, registered and issued by national patent offices. Whilst the Preamble envisaged unification of national legislations at some point in the future, the proposal not only deferred to national laws on matters relating to validity and revocation²⁴ but also conferred on national patent offices the power to make final decisions on patentability to reflect national laws except on novelty where the decision of the European Patent Office was to be final.²⁵

The rationale for greater integration and unification detailed in the Preamble was threefold, and its echoes may still be heard in the unification movement today.²⁶ Inventors would benefit from being able to secure cheaper, more effective and legally secure patent protection; uniform protection would avoid delays and duplication amongst national patent offices, enabling efficiencies of scale to be made by Member States pooling together technical knowledge and resources. Finally, national industries would, in turn, benefit from the innovative activities of inventors. Thus, in the closing of this virtuous economic circle, the interests of inventors/investors and industry took center stage and were assumed to coincide with the wider interests of society as a whole in a new world order where national economic, social and cultural differences would give way to unity.²⁷

But the distance between the narrative for greater unity and the reality of the resistance of national interests to being absorbed into a supranational order is evident in the outcome of the minimalist 1949 draft Convention. The minimalist reform would have created a new pan-European administrative office to manage a centralized procedure for the grant of patents *alongside* the existing national patent offices with no real disruption to the legal structure and norms of national legal orders. The Convention implicitly assumed that the test for novelty, or the question of whether an invention adds anything new to the existing art/science, is a technical, factual question which can be objectively determined by searching published prior art.²⁸ Nonetheless, even this minimalist proposal could not secure agreement. Part of the difficulty was that the proposal involved duplication of the role already

²³ *Op. cit.* 18, Art. 2.

²⁴ *Op. cit.* 18, Art. 3.

²⁵ *Op. cit.* 18, Art. 1.

²⁶ These were also mixed with political motivations and a naïve assimilation of national and European interests against common enemies reflected in the “widespread determination to overcome the narrow-minded nationalism which once had created patent laws, mainly in the 19c, in order to protect national industrial production against dangerous foreign competition.” Neumeyer (1961) at p. 727 where the UK is described as the “big brother” in the EFTA Agreement of 1959 uniting the “outer seven” outside the European common market. Austria, Denmark, Norway, Portugal, Sweden, Switzerland, and the United Kingdom who decided to join together in the EFTA to strengthen their future bargaining power in establishing the wider free trade area.

²⁷ A similar unifying vision is still shared by leading economists of the European Patent system today, for instance Guellec and van Pottelsberghe de la Potterie (2007).

²⁸ Empirical studies conducted in Germany in 1941 and 1942 showed that in 99 % of all European cases, novelty depends on the printed publication (publication of prior art): cited by Spencer (*supra* note 7) at p. 1159.

assumed by the International Patent Institute at The Hague.²⁹ But the more serious difficulty was the diversity of national laws on patents. For this reason, the Council of Europe's Committee of Ministers decided that the Recommendation could not be carried out in its current form.³⁰ The Council of Europe's Committee of Experts on Patents (CEP), formed in 1950 and made up of heads of patent offices and representatives of Member States, was asked to investigate further how unification could be achieved.³¹ The CEP continued with its work and recommended the adoption of two other Conventions which, though modest in scope would, years later, facilitate the practical implementation of a centralized system.³² The first Convention, signed on 11 December 1953, set out uniform requirements relating to formalities in the form and processing of patent applications.³³ The second Convention, signed a year later on 19 December 1954, made provisions for the adoption of uniform system of classification of patents.³⁴ The Preambles of both Conventions recall the wider economic and social mission of the Council of Europe. In addition, the later IPC Convention further declares in its Preamble that the "adoption of a uniform system of classification of patents for inventions is in the common interest" anticipating, correctly as it later turned out, that this Convention was "likely to contribute to the harmonization of national legislation."

The CEP also considered several other proposals for unification which could not secure agreement.³⁵ The two main proposals encapsulated radically different visions. One option envisaged mutual recognition and validation of national patents granted in other territories applying different criteria. This was rejected by some on the grounds that it would impose too great a cost on industry and courts.³⁶ The alternative proposal envisaged unification of substantive patent law and a unified European court with exclusive powers of enforcement. The difficulty here, as some of the (invited) observer States noted, was that unification of laws was not a simple, purely technical legal matter because patent requirements and laws reflect national economic priorities and policies.³⁷ Thus, in 1955, the CEP reported to the

²⁹ See Wadlow (2010), *op. cit.* Some commentators have suggested that this was because the proposal was ahead of its time but compared to subsequent proposals the proposal is minimalist in the extreme.

³⁰ Committee of Ministers Report to Parliamentary Assembly (1953) 4th session. Doc. 122, 7 May 1953.

³¹ See CM/12 (1952) 89 also cited in Consultative Assembly of the Council of Europe Doc. 1161 reporting reply of the Cttee of Ministers to Written Question No. 73 by Mr. Heckscher regarding the work of the Cttee of Experts on Patents, at p. 1.

³² Resolution (1952) 49 on the examination of patent applications for novelty and resolution (1952) 50 on a uniform system of patent classification and (52) 51 on the plan of future work for the CEP. See supplementary report of the Third Report of the Committee of Ministers (Doc. 42 (1952) Part I, chapter I (c)). Also cited in Doc. 1161 *supra*.

³³ CETS No: 016 European Convention relating to the Formalities required for Patent Applications, signed in Paris on 11 December 1953.

³⁴ CETS No.: 017 European Convention on the International Classification of Patents for Inventions, signed in Paris on 19 December 1954.

³⁵ *Op. cit.* 31, Doc. 1161. For a detailed discussion see Wadlow (2010).

³⁶ Mr. M. Gilham, UK representative, COE, CM (1955) 137, p. 2.

³⁷ M. Bolla (observer from Switzerland), COE, CM (1955) 137, p. 3.

Committee of Ministers that, before it could proceed further, two questions had to be settled. The first question was whether some degree of unification of laws was necessary for the creation of a European patent. In the affirmative, then which laws should be unified and which should remain national laws?³⁸ The Committee of Ministers concurred that national patentability criteria were so diverse that some degree of unification of the substantive, “material” laws had to take place before approaching the second question.³⁹ The Committee of Ministers thus resolved that the CEP should progress its work and focus in the first instance on the unification of the national patenting criteria for “industrial character”, “technical progress”, “creative effort”, priority and description of claims.⁴⁰ National delegations were invited to submit comments on all these aspects. Five rapporteurs⁴¹ were also appointed to draw up reports.

Progress was very slow. By 1960, only one of the special Rapporteurs had completed his report – dealing with “novelty”. This prompted the Consultative Assembly of the Council of Europe to ask the Committee of Ministers, in a written question, what had happened to the work of the Committee of Experts on Patents.⁴² The CEP was urged to complete its study and it finally did this in 1962. Despite the laborious and drawn-out nature of the task, there is no doubt that the collection of national laws and comments and their triangulation by the CEP rapporteurs provided the founding stone on which to build the Council of Europe’s Convention on the Unification of Certain Points of Substantive Law on Patents for Invention in 1963 (known as the Strasbourg Convention).⁴³ Article 1 of the Strasbourg Convention⁴⁴ laid down the elements of a common, substantive, European patent law – novelty, inventive step and industrial application – without which centralization of the administrative procedure for the grant of European patents could not have taken place a decade later. The Strasbourg Convention had ironed out the seemingly insurmountable differences in national patent laws which did not permit patents for many types of applications, including chemical and pharmaceutical products⁴⁵ through the adoption of a simplified, maximalist threefold common denominator. Henceforth, the unitary model of the legal requirements for an invention followed the basic threefold template set out in the Strasbourg Convention, leaving methods of enforcement, national exceptions and choice of applicable laws post-grant to national laws.

³⁸ *Ibid.*

³⁹ COE, Resolution CM (1955) 137, p. 9.

⁴⁰ *Ibid.*

⁴¹ From France, Germany, Belgium, Switzerland and Sweden.

⁴² COE, CA, Written Question 73, 29 April 1960 (Doc. 1149).

⁴³ As argued by Wadlow (2010).

⁴⁴ Article 1 of the Strasbourg Convention provides that in the Contracting States, patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step. An invention which does not comply with these conditions shall not be the subject of a valid patent. A patent declared invalid because the invention does not comply with these conditions shall be considered invalid ab initio.

⁴⁵ See Bentley L’s Expert Study on Exclusions of Patentable Subject Matter and Exceptions and Limitations on Patentees rights conducted for WIPO (2011).

The adoption of the Strasbourg Convention was poised to become the high point of the Council of Europe's activities in the field of patent unification. The institutional torch for patent unification had already passed onto the EEC in the late 1950s, marking the start of a new phase and rationale for patent harmonization in Europe which built on the *acquis* from the Council of Europe. With hindsight, the salient features of this *acquis* were threefold. First, industry and national patent offices had acquired a driving role in the political project for patent unification in Europe. Secondly, a major restructuring of national patent systems had been set in train with minimal political oversight. As a leading German commentator lamented in the 1960s, the Committee of Experts on Patents (CEP) were "meeting behind closed doors and all the proceedings and working documents remain confidential ...".⁴⁶ The aim was to facilitate informal discussions and compromise, but the downside was that the decisions were not open to the same degree of public scrutiny as national laws.⁴⁷ Thirdly, potential constitutional tensions between national interests and the limitations on national sovereignty entailed by unification and the role of international organizations were latent but had not yet fully erupted. As von Holstein pointed out, "legislative power" had been handed over to the Council of Europe's CEP: "If no State protests its decision becomes law and it even becomes law if one State protests ... It may not be very risky for the States to accept this system in this field but it is nevertheless an interesting renunciation of the autonomy of the sovereign States as a matter of principle."⁴⁸ Finally, as the EEC took over the unification agenda, the political ambitions and limitations of the EEC in achieving unification became apparent. The next section documents the strains which erupted in the next phase leading to the adoption of the European Patent Convention (EPC) and the creation of the European Patent Organization (EPO).

3 The EEC's Ambition: Unification Through (Dis)Integration

The territorial nature of the patent system was always poised to grate with the vision of an ever-closer union and the smooth functioning of a common market⁴⁹ as envisaged by the contracting States in the first Treaty creating the European Economic Community in 1957.⁵⁰ The Preamble to the Treaty declared the States intention to remove existing obstacles to trade by means of a common commercial policy whilst Arts. 2 and 3 detailed the means to achieve the goal of closer integration through the approximation of economic policies and laws, elimination of restrictions on import and export of goods. Unsurprisingly, six months into the creation of the EEC and from the beginning of 1958, the heads of the national patent offices of the six contracting States had begun to meet to discuss the impact of the Treaty on the unification of national laws at the instance of, M. Finniss, the head of

⁴⁶ Von Holstein (1967).

⁴⁷ *Op. cit.* 46. Sixty years later, hard copies of the confidential records may be accessed by researchers in selected repositories but few have been digitalized.

⁴⁸ *Op. cit.* 46, at 201.

⁴⁹ See Ullrich (2002).

⁵⁰ Treaty Establishing the European Community (Consolidated Version), Rome Treaty, 25 March 1957.

the French national patent office. These meetings are mentioned in a confidential note from H. Suenner, Head of the Directorate for the diffusion of knowledge at EURATOM.⁵¹ The note indicates that the meetings had originally taken place on an informal basis and that the EEC only became formally involved and set-up a working group in 1959 in response to suggestions from the Secretary of State for Economic Affairs from the Netherlands and the Secretary of State for Justice from Germany.⁵² The note also evidences the Commission's initial reluctance to initiate action in this field, prompted by doubts about the legal basis of such an action under the EEC Treaty. The doubts concerned the Commission's competence under Art. 100 which, at the time, was limited to acts which *directly* affected the establishment or functioning of the common market. The Commission was uncertain whether the diversity of national patent laws had a direct effect on the functioning of the common market or whether the effect was indirect and if so, outwith the scope of Art. 100.⁵³ Neither was it clear whether the differences in national laws, by themselves, caused harmful distortions to competition, contrary to Art. 101.⁵⁴ Another stumbling block was Art. 36 of the EEC Treaty which permitted States to introduce

prohibitions or restrictions on imports, exports or goods in transit justified on grounds of public morality, public policy or public security; the protection of health and life of humans, animals or plants; the protection of national treasures possessing artistic, historic or archaeological value; or the protection of industrial and commercial property.

Thus, it was thought that recourse to a separate international agreement may be needed as a means of circumventing Art. 36. But under pressure from the President of EURATOM,⁵⁵ the Commission nevertheless agreed to set up a coordination meeting with representatives of Member States in the autumn of 1959 to consider the problems raised by the lack of a uniform patent system.⁵⁶

⁵¹ Note marked "Urgent – Tres Confidentiel" from Euratom's Directorate for the Diffusion of Knowledge to the Members of the Commission, EUR/C/174/59 f". The note was written because EURATOM wanted to be a party to discussions about the creation of a uniform patent for EEC members.

⁵² *Op. cit.* 51. The officials mentioned were Mr. Veldkamp (Netherlands) and Mr. M. Strauss (Germany).

⁵³ EU/C/174/59 f at p. 2. The Commission's doubts about the legal basis of concerted action under Art. 100 are also reiterated in another note from Mr. Suenner (Head of the Directorate for the Diffusion of Knowledge at Euratom) addressed to the Vice-President of Euratom, dated 14 July 1959 – BAC 0027.

⁵⁴ *Op. cit.* 53.

⁵⁵ Note from the Directorate for the Diffusion of Knowledge for the Attention of the Vice-President of Euratom, Brussels, 28 July 1959. BAC 0033.

⁵⁶ The meeting was convened by Mr. von Der Groeben, Commissioner of the Common Market and led to the creation of a coordinating committee composed of the heads of national patent offices and other officials from Member States. See von der Groeben, H. (1959) Allocution de M. von der Groeben a l'occasion de la reunion du 19 novembre 1959 sur le rapprochement des legislations dans le domaine de la propriete industrielle. 19 novembre 1959 = Speech by Mr. von der Groeben [Member of Commission of the European Economic Community] on the occasion of the meeting on the 19th of November 1959 regarding the formation of industrial property laws. 19 November 1959. [EU Speech] and Finet, Paul and Hirsch, Etienne and Hallstein, Walter. (1959) Interview of Three European Community Presidents, President Paul Finet [High Authority of the ECSC], President Etienne Hirsch [Commission of Euratom], and President Walter Hallstein [Commission of the European Economic Community]. National Press Club. Washington DC, 11 June 1959. [EU Speech]. Spencer (1962) at 747.

A note of 30 July 1959, in advance of the meeting, points to “the absence of definitive results from the work conducted at the Council of Europe, in part due to the fact that the participants are not fundamentally bound by common economic interests.”⁵⁷ The note sketches, for the first time, a distinctive EEC rationale for harmonization of patent laws as a tool for the realization of the common market.⁵⁸ Unification of patent laws, the note claims, would enhance legal security in the totality of the economic space of the EEC, something which is particularly critical in relation to the protection of rights affecting competition.⁵⁹ Thus, a working group of experts on patents was set up with a mandate to consider whether it was necessary and if so, how it would be possible to attenuate or eliminate the economic disparities arising from the existence of different regimes of industrial property rights which might impact adversely on the operation of the internal market and have a distorting effect on competition.⁶⁰ The group’s work was to be guided by the principle that harmonization of European patent laws had to coexist with national legal regimes whilst an EEC patent would confer a unitary and autonomous title.⁶¹ Whether these two principles could be reconciled in a Convention was less clear.⁶²

The resulting draft proposal for a European Patent Convention (*Avant-Projet de Convention relatif a un droit Europeen des Brevets*) of 1962 ran to 107 pages in length and contained 217 articles.⁶³ It envisaged the creation of a European Patent Court (*Court Europeenne des Brevets*)⁶⁴ with jurisdiction to hear appeals from a European Patent Office and competence to interpret the Convention. But, the relationship of this court to other courts, including international courts was deliberately left open by the working group, and it was anticipated that the powers and jurisdiction of the court would have to be determined by means of a separate instrument.⁶⁵ The text of the draft Convention also refers to the court as a court of final instance, but is not clear as to the relationship of this court to the ECJ. Separate notes indicate that there were doubts as to the ECJ’s competence which was thought may be limited to scrutiny of the public law aspects of the proposed convention. It was also thought that a separate European court with jurisdiction over civil matters

⁵⁷ IV/3462/1/59 F.

⁵⁸ As noted by Bossung who mentions that in early work of the Council of Europe initiated in Strasbourg in 1949 “it had not been possible to define the objectives of a European patent system as roughly the ‘realization of a common market’, (now EC Treaty) would in no way affect ‘industrial and commercial property.’” Bossung (1996) at 289.

⁵⁹ IV/3462/1/59 F.

⁶⁰ Comité de Coordination, Bruxelles 3 Février 1960, EUR/C/294/60. The initial participants in the EEC Patent Working Group were mainly heads of national patent offices drawn from Germany, Belgium, France, Italy, Luxembourg, Netherlands, as well as representatives from EURATOM, EGKS, CECA, EWG and the Commission.

⁶¹ Preamble, *Avant-projet de convention relatif a un droit europeen des brevets* élaboré par le groupe de travail “brevets” = Preliminary draft convention on a European patent law drafted by the Patent Working Group. [EU Commission – Working Document] available at Archive of European Integration.

⁶² According to Bossung, this was certainly the view of Kurt Haertel, chairman of the EEC working group on patents, at 289.

⁶³ Access: <http://aci.pitt.edu/14064/1/PATENT-FRENCH.PDF>.

⁶⁴ *Avant Projet de Convention*, Art. 4. BAC 0067 and 0068 – p. 8.

⁶⁵ *Op. cit.* 64, Art. 4 and Remarques.

might have to be created to hear some aspects of disputes.⁶⁶ Pending further input from ministries of justice and international affairs, the EC working group on patents consciously refrained from elaborating further on the interaction of the proposed Convention with the EEC Treaty and national and international laws.⁶⁷

According to Bossung, a member of the EC working group,⁶⁸ the UK officially announced its interest in participating in the agreement in 1963⁶⁹ but negotiations broke down so “the choice between a European patent – open to non-EEC members – or an EC patent became a major issue.”⁷⁰ The draft-convention and report of the coordinating committee were remitted to the Council in 1964 and in early 1965 the Council decided that the Commission needed to conduct a more detailed and in-depth examination of several aspects of the proposed Convention in order for the Convention to meet three distinct objectives.⁷¹ The first was to enable inventors to secure uniform protection in the widest possible territory. The second was to simplify procedures and costs of examination. The third was to ensure that harmonisation of industrial property rights would contribute to the realization of the economic union envisaged by the EEC Treaty.⁷² In the view of the Council, the last objective would require the eventual substitution of the national laws of the six members of the EEC by a uniform law in order to achieve the progressive realization of the common market.⁷³ By contrast, the creation of a wider European patent open to all applicants could be achieved through the adoption of an international agreement with common rules for the grant of patents, leaving the legal regime relating to the enforcement and exploitation of patents to be determined by national laws.⁷⁴ Thus, the elaboration of the legal architecture of the proposed EC patent convention and the relationship between EEC law, European Patent law, international law and the institutions remained unclear.⁷⁵

In the absence of a clear proposal which could secure agreement, momentum built up in favor of an international (European) convention instead of an EC/

⁶⁶ *Op. cit.* 64, BAC 0067 and 0068.

⁶⁷ See Preamble of Avant-Projet. Groupe de Travail “Brevets” Annexe A 0074.

⁶⁸ Bossung, *O. op. cit.*, at 287.

⁶⁹ *Op. cit.* 71. Bossung’s dates do not correspond to the official record. In a confidential note dated 22 July 1963, the UK ambassador, C. O’Neill, expressed the UK’s wish to be permitted to take part in the development of the draft convention with a view to ultimately acceding to the agreement: R/673/63 (ECO 19) sv. At that point in time, the UK indicated that it had concerns about bifurcation and was in favour of branches of the EPO being established in different patent offices in Europe.

⁷⁰ *Op. cit.* 68, at 287.

⁷¹ Comité des Représentants Permanents au Conseil, Note R/189.f/65 (ECO 18) 25 February 1965 and Rapport R/189.f/65 (ECO 8) (Annexe).

⁷² Rapport du Comité des Représentants Permanents au Conseil, R/189.f/65 (ECO 8) (Annexe) am, p. 2.

⁷³ *Op. cit.* 72. The delivery of this objective through an EEC uniform patent became known as the “Groeben plan”. See Neumeyer (1961). “The radical suggestions made in this ‘Groeben plan’ are intended to culminate in a totally unified European patent and trademark legislation, giving up the basic principle of territoriality of national industrial property rights at the end of the transitional period of the Common Market.” at p. 728.

⁷⁴ *Op. cit.* 72, p. 3.

⁷⁵ According to Bossung, for these reasons, the work of the group remained confidential and largely forgotten today. *Op. cit.* 68 at 291.

Community Patent Convention, as two distinct forces began to converge. On the one hand, the Patent Convention would have to accommodate the UK, not yet a member of the EEC but hosting one of three leading patent offices in Europe.⁷⁶ The UK itself had indicated that it was open both to the international solution which would lead to a “bundle of national patents and also to a ‘tighter’ scheme ... designed to ensure that the patent carried identical rights in each country” including enforcement of validity, provided the UK was represented on it.⁷⁷ Either way, the UK’s participation in a European Patent Convention could not be as a contracting member of the EEC and required a separate agreement. Furthermore, it was feared, particularly by the French, that if the unification project in Europe continued to stall, Europe would be sidelined and flooded with patents from countries with a strict examination system, especially the US, following the adoption of the Patent Cooperation Treaty.⁷⁸ It is against this background that Jacques Debre, French Foreign Minister, took the initiative to rekindle the unification project in late 1968. But this time the project was very quickly split into two distinct projects. One project was to elaborate a European Community Patent Convention under the umbrella of the EEC⁷⁹ and the other was to elaborate a broader, international patent convention open to non-EEC members.⁸⁰ The latter project was undertaken under the umbrella of an intergovernmental conference convened on 21 May 1969 involving 17 States.⁸¹

The intergovernmental working group determined that substantive unification of national patent laws created too many legal difficulties and decided that the only feasible option at that point in time was to agree on a common procedure for the grant of patents “without agreement about their effect and validity after the grant”⁸² which would be determined by national laws. An Intergovernmental draft European Patent Convention based on these principles was released in 1970 and, following consultations with national chambers of commerce, industry and patent agents, was

⁷⁶ *Op. cit.* 68 at 289.

⁷⁷ C. O’Neill, UK Delegation to the European Communities, Memorandum: Certain points relating to the British position on a European Patent Convention, Brussels 25 February 1965.

⁷⁸ Deringer (1971) at 152.

⁷⁹ The working group delivered a report that was considered by the Council on 7 February 1969. The report is contained in document R/209/69(ECO 31). The Comité des Représentants permanents, at its 513^{ème} reunion 20–23 May 1969 mandated the Groupe d’experts Brevets Européens to continue its work on a unitary patent for the EEC six: Document 774/69 (RP/CRS 18) 6 June 1969. The head of the EEC parliament requested that a copy of the group’s report be made available to parliament (letter dated 20 August 1969, R/1534/69 (Ass. 799) and this was refused by the Council in a letter marked “Confidential”, bearing two dates, 23 IX 1969 and 18 September 1969. The grounds for the refusal were that the discussions involved parties outside the EEC and also would create a precedent.

⁸⁰ The EEC working group was led by M. Haertel and reported back to the Comité des Représentants Permanents on 29 January 1970 in doc. R/11/70 (ECO 3) (BC2). The intergovernmental group was led by M. Savignon (Head of IPO in Paris) and reported in doc. R/10/70 (ECO 2) (BC 1).

⁸¹ The 17 members of the intergovernmental group were the six members of the EEC (Belgium, France, West Germany, Italy, Luxembourg, the Netherlands), (members of EFTA) Austria, UK, Denmark, Norway, Portugal, Sweden, Switzerland and Greece, Ireland, Spain, Turkey, Monaco, Yugoslavia, Finland and Liechtenstein. See van Benthem, “General Report” to First Preliminary draft of the EPC.

⁸² Deringer, at 153–154.

adopted in Munich on 5 October 1973,⁸³ three years after the adoption of the Patent Cooperation Treaty adopted in Washington on 29 June 1970.⁸⁴ The European Patent Convention (EPC) is an international treaty,⁸⁵ creating a European Patent Office⁸⁶ under the auspices of the European Patent Organization with the power to grant a European Patent having the same effect in a Contracting Member State as a national patent granted by that State.⁸⁷ The EPC “maximalist” requirements for the grant of a patent (novelty, inventive step and industrial application) were lifted from the earlier Strasbourg Convention,⁸⁸ whilst national exceptions to patentability are permitted in limited circumstances.⁸⁹ The EPC also created an internal procedure within the EPO for oppositions and appeals on the decision of an examining division to grant a patent.⁹⁰ Once granted, a European patent becomes a “bundle” of patents whose validity and enforcement are subject to the national laws of each designated State.

The EEC working group sought to embed the community patent in the (international) European patent while the two models were developed in tandem. The international/European patent was meant to be a temporary compromise. But, as Bossung remarked, once harmonization was handed over to an intergovernmental organization outside the EEC, it would be very difficult for the EEC and Member States to control its direction.⁹¹ The (international) European patent project overtook and eclipsed the EEC unitary project, notwithstanding the fact that the invitation to participate in the work on European patent law issued by the EEC countries in 1968 to non-EEC members was not intended to result in relinquishing control over a major aspect of patent law, preventing themselves from employing this part of patent law for the purposes of the internal market.⁹² The difficulty now facing the realization of the EEC’s goal of patent unification to serve the internal market was the emergence of a new transnational European institution outside the legal order of the EEC, as the main administrative engine for the grant of European patents based on the norms of a separate Treaty, when the “EPC’s *raison d’être* is not to serve community law nor can this objective be deduced from the Preamble.”⁹³ These difficulties and the

⁸³ As of 2014, 38 States are members to EPC (all EU Member States, the EFTA States, Turkey, Serbia, Republic of Macedonia, Albania, Monaco, and San Marino).

⁸⁴ Article 1(1) PCT provides that: The States party to this Treaty (hereinafter called “the Contracting States”) constitute a Union for cooperation in the filing, searching, and examination, of applications for the protection of inventions, and for rendering special technical services. The Union shall be known as the International Patent Cooperation Union.

⁸⁵ And regional Treaty within the meaning of Art. 45(1) of the Patent Cooperation Treaty.

⁸⁶ Article 4(2)(a).

⁸⁷ Article 2(2).

⁸⁸ Article 52(1): European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.

⁸⁹ On the genesis of Arts. 52 and 53 EPC, see Pila (2010).

⁹⁰ *Op. cit.* Bossung, at 298.

⁹¹ *Ibid.*

⁹² (Articles 7(a) and 100(a) of the EC Treaty) and the technological development of the Community (Article 130(f) EC Treaty) at 298.

⁹³ Or from Arts. 142–149. See Bossung, *op. cit.* at 298.

underlying latent questions regarding the scope of surrender of national sovereignty in economic and industrial policy, the accountability of international organizations and opportunities for public and judicial scrutiny of patent policies gathered momentum in the final phase of the unification movement which culminated in the “patent package” challenged by Spain.⁹⁴

4 Towards a Disjointed and Uncertain Union

Tensions between the EEC and the intergovernmental initiative can retrospectively be gleaned from the secrecy surrounding the work of the intergovernmental group from which the EEC Parliament was shielded⁹⁵ as well as the eruption of intra-institutional tensions within the EEC itself.⁹⁶ In 1969, Mr. Groeben, Commissioner for the Common Market, had expressed alarm at the prospect of postponing the adoption of the community patent and the extension of the transition period for the introduction of the community patent in the proposal of the EEC group which had been working in parallel with the international group. He enjoined members of the Commission to impress on the EEC working group the need to keep the transition period to a minimum in view of the critical strategic implications for the internal market.⁹⁷ Territorial limitations which preclude exploitation beyond national borders, he said, had to be *eliminated*.⁹⁸ The risks of market fragmentation were particularly high, Groeben said, in circumstances where a patented product is being manufactured by just one manufacturer who can take advantage of the sectioning of the market to sell the product at different prices so as to derive maximum profit at the expense of consumers.⁹⁹ As noted by the ECJ in cases C-56 and C-58/64 (*Grundig-Consen*), Groeben added, such practices coupled with the use of exclusive licenses can create artificial markets and distort competition.¹⁰⁰ Groeben’s note also drew attention to the ECJ’s ruling in *Parke-Davis* (C-24/67) that, in the absence of uniform protection across the EEC “... the diversity of national laws is liable to create obstacles to the free movement of patented products and to fair competition within the common market.”¹⁰¹ Yet, Groeben also admitted that it was known, unofficially, that certain States were worried about the potential adverse economic impact on local economies and feared that

⁹⁴ For a critique of the political underpinnings of patent unification in Europe see for instance, Schneider (2009).

⁹⁵ *Supra* note 79. Nonetheless, the EEC Parliament adopted a resolution on 5 February 1970 welcoming the renewed initiative for a European patent: 205 f/70 (Ass. 132) amv.

⁹⁶ *Supra* note 79.

⁹⁷ The first meeting of the working group was to take place from 7–10 October 1969.

⁹⁸ (My translation and emphasis. The French word is *éliminé*. Communication de Monsieur von der Groeven, Secretaria General SEC (69) 3666, Problemes Relatifs a l’elaboration d’une convention sur un brevet europeen pour le marche commun, Bruxelles, 7 Octobre 1969. BAC 000317, 000318 ff at 000322.

⁹⁹ *Ibid.* at 000325.

¹⁰⁰ *Ibid.* at 000325.

¹⁰¹ *Ibid.* at 000325.

patent unification could result in a displacement of production at the expense of national industries. But he was convinced that these difficulties could be resolved by legal means.¹⁰²

Thus, the draft Community Patent Convention, developed by the EEC working group in 1969 in parallel with the international convention, had to resolve the internal political ambivalence and tensions within the EEC itself about the extent of dissolution and elimination of national laws which the EEC required in order to achieve the goal of patent unification. The ambivalence is manifest in the evolution of the draft EEC texts in two areas which are critical to the coherence and integrity of the legal architecture of the community patent. The first area relates to the respective competences and hierarchy of national and supranational courts charged with enforcement and adjudication of disputes post-grant. The second fuzzy area relates to the substantive applicable law(s).

Whereas the 1962 EC draft convention had proposed the creation of a European Patent Court whose relation to other courts and the ECJ had been left open, the revised EC draft proposal specifically envisaged that the ECJ would be competent, in the last instance, to hear actions relating to the EC/Community patent.¹⁰³ In the 1973 version of the EC draft which formed the basis of the text of the (Luxembourg) Community Patent Convention of 1975,¹⁰⁴ the ECJ was to hear appeals from “Chambres d’Annulation” charged with nullity proceedings (Art. 67)¹⁰⁵ as well as appeals from national courts with jurisdiction over infringement proceedings (Arts. 77 and 78). The uniform and autonomous character of the community patent was to rest on Art. 2(3) which declared that the unitary character of the community patent resulted from it having effect for the whole of the EC territories and contracting States and the fact that it could only be transferred or extinguished for the whole of these territories. Autonomy was guaranteed by the fact that community patents would only be subject to the rules under this Convention (whose authoritative interpretation ultimately rested with the ECJ).

Yet, behind the language of uniformity and autonomy, there were important areas of ambiguity concerning the applicable laws and the scope of jurisdiction and hierarchy of courts. The ECJ, expressing its “vive satisfaction” at being consulted in 1970,¹⁰⁶ drew attention to a number of areas which required further clarification and precision, notably the legal basis for appeals, the effect of an appeal to the ECJ under Art. 67¹⁰⁷ as well as the limitation of the ECJ’s appeal jurisdiction to infringement proceedings in Art. 77. In the Court’s view, it would be preferable to extend the competence of the court (ECJ) to “any question on interpretation or

¹⁰² *Ibid.* at 000326.

¹⁰³ Article 4.

¹⁰⁴ Convention for the European patent for the common market (Community Patent Convention) 1976 O.J. L 17/1, 26/01/1976.

¹⁰⁵ These were to become the Appeal Boards of the EPO in the EPC (1973).

¹⁰⁶ Cour de Justice des Communites Europeenes, Luxembourg, 15 May 1970, R/1029/f/70 (ECO 97) (BC 13).

¹⁰⁷ *Ibid.*, p. 2 (0269).

validity arising from the Convention in proceedings concerning the EC patent in national tribunals by means of a general clause”.¹⁰⁸

The compromise final text in the Convention for the European patent for the common market (Community Patent Convention or CPC) of 1975¹⁰⁹ created a system of community patent divisions with jurisdiction over nullity and revocation proceedings whilst national courts had jurisdiction over infringement proceedings but only in respect of acts of infringement committed within that State.¹¹⁰ National courts were also to enjoy exclusive jurisdiction over compulsory licenses, but limited to the State’s territory.¹¹¹ Preliminary appeals to the ECJ on points of law were allowed but only in respect of the validity and interpretation of provisions implementing the CPC and the European Patent Convention, and only “to the extent that they are not national provisions.”¹¹² Thus, behind the Preamble’s aspiration to give “unitary and autonomous effect to European patents granted in respect of their territories under the Convention on the grant of European patents of 5 October 1973”, the legal reality was a complex legal order which interwove but did not fully integrate national legal orders with the EPC and community legal orders. Unsurprisingly, although nine Member States of the EC had signed the Convention in Luxembourg on 15 December 1975, only seven members ratified the CPC. So, the CPC never entered into force.¹¹³

5 The “Patent Package” in the Shadow of History

Difficulties in securing agreement persisted and led to further negotiations and variations in a renewed attempt to adopt a Convention in 1989 which also failed to secure ratification from all Member States.¹¹⁴ The unification project may have been “ill-born” and in the view of some “a major failure of unification of industrial property law and policy” but the Commission never let go of the ambition.¹¹⁵ The historical legacy of the persistent aborted attempts to create a unified European patent system is reflected in the persistent difficulties in achieving integration of

¹⁰⁸ *Ibid.* p. 3 (0270).

¹⁰⁹ Convention for the European patent for the common market (Community Patent Convention) of 15 December 1975, 1976 O.J. L 17/1, 26/01/1976.

¹¹⁰ Subject to residence requirements. In the event that the residence requirements were not satisfied, the CPC designated the courts of the German Federal Republic (Art. 69(1)).

¹¹¹ Article 69(4).

¹¹² Article 73(1). In proceedings relating to a Community patent which are brought before a national court or tribunal, the Court of Justice of the European Communities shall have jurisdiction to give preliminary rulings concerning: (a) the interpretation of this Convention and of the provisions of the European Patent Convention which are binding upon every Community patent in accordance with Article 2(3); (b) the validity and interpretation of provisions enacted in implementation of this Convention, to the extent to which they are not national provisions.

¹¹³ The nine States were: the UK, the Netherlands, Luxembourg, Italy, Ireland, France, Belgium, Denmark and Germany. See Sugden (1991). See Benyamini (1993).

¹¹⁴ Agreement Relating to Community Patents – done at Luxembourg on 15 December 1989, OJEC 1989 L.401.

¹¹⁵ Ullrich (2002) at 438.

diverse national laws whose roots betray different national socio-economic priorities. After adoption of the EPC, the complexity of integrating patent laws and adjudicating institutions *pre-* and *post-*grant was considerably magnified. Unification now required triangulation and alignment of the EU market oriented goals with national patent systems and an autonomous, rival pan-European institution, which had been vested with the power to apply “A system of law, common to the Contracting States, for the grant of patents for invention.”¹¹⁶ The challenge of integration *post-EPC* thus required specification of how the EPC “system of law” and norms applied by EPO boards would relate both to national laws and the EU legal order.

With this new challenge ahead and the failed Convention of 1989, the Commission revived its efforts ten years later in a Green Paper “Promoting Innovation through Patents – Green Paper on the Community Patent and the Patent System in Europe.”¹¹⁷ The paper formed the basis of a proposal for a Council Regulation on the Community patent (COM (2000) 412 final), which envisaged accession of the Community to the EPC, the creation of a unitary industrial property right valid throughout the Community and the granting of that right by the EPO. The end-point of discussions with the Competitiveness Council of 4 December 2006 and the European Council of 8 and 9 March 2007 was a final proposal presented by the Commission to the European Parliament in a Communication dated 3 April 2007. The proposal “Enhancing the patent system in Europe” (COM (2007) 165 Final) provided that a Community Patent would be granted by the EPO and would have unitary autonomous character throughout the Union. A draft international agreement between Member States, the Union and third parties to the EPC would also have established a European Community Patents Court with exclusive jurisdiction over the community patent. On the 8 March 2011, the proposal was rejected by the Grand Chamber of the CJEU in Opinion 1/09 declaring the agreement incompatible with the Treaties. The Court observed that, whilst the proposed Patent Court would have powers to interpret and apply EU law, its exclusive jurisdiction would deprive national courts of their task, as “ordinary” courts within the European Union legal order, to implement European Union law and or, as the case may be, the obligation, to refer questions to the CJEU for a preliminary ruling in the field concerned (at para. 80).

The Commission responded with a revised proposal for the creation of a Unitary Patent¹¹⁸ and translation arrangements. The new proposal could not secure unanimous support. In the absence of a consensus amongst Member States of the European Union, the mechanism of enhanced cooperation was controversially relied upon¹¹⁹ to create the so-called “Unitary Patent” with the participation of 25 out of

¹¹⁶ Article 1 EPC.

¹¹⁷ [COM (1997) 314 final] and European Commission (1999). Communication from the Commission of 5 February 1999. Promoting Innovation through Patents.

¹¹⁸ Regulation (EU) No. 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection and Regulation 1260/2012 (translation arrangements).

¹¹⁹ The Spanish challenge to the use of enhanced cooperation was dismissed by the CJEU on 16 April 2013: C-274/11 and C-295/11.

the 28 EU contracting States.¹²⁰ A revised proposal for a “Unified Patent Court” was the subject of a separate international agreement.¹²¹ The new “patent package” consisting of a Unitary Patent (EPUE) and a Unified Patent Court (UPC), was intended to overcome the longstanding political and legal difficulties which had stood in the way of substantive harmonization of national patent laws and integration of patent institutions and courts in Europe. Whether it has achieved this is far from clear, notwithstanding the Opinion of the Grand Chamber of 5 May 2015, dismissing Spain’s legal challenge.¹²² The areas of persistent difficulty, it is suggested in the remainder of this paper, pertain to the uncertainty relating to the degree of unification achieved in the applicable substantive material laws, and the continuing fractured legal architecture and lack of integration of the EPC and EU systems. The limited light cast by the Grand Chamber’s Opinion on the challenges ahead are highlighted with a case study in the final section.

5.1 CJEU Judgment on the Unitary Patent and Unified Patent Court

The Preamble of the contested EU Regulation creating the unitary patent or European patent with unitary effect (EPUE) states that the legal basis of the Regulation is Art. 118 of the Lisbon Treaty.¹²³ Article 118 of the Treaty on the Functioning of the European Union (TFEU) mandates the establishment of measures for the creation of European intellectual property rights to provide uniform protection of intellectual property rights throughout the Union and for the setting up of centralised Union-wide authorisation, coordination and supervision arrangements. In an action for annulment of the Regulation, as incompatible with the Treaties, Spain submitted that Art. 118 TFEU was not an adequate legal basis for adopting the contested regulation and that its adoption had not been accompanied by measures providing uniform protection of intellectual property rights throughout the Union nor did it bring about an approximation of the laws of the Member States for that purpose.¹²⁴ Dismissing the objection, the Grand Chamber of the Court of Justice of the European Union stated that uniformity was guaranteed by Art. 3 of the contested Regulation which provides for unitary effect amongst the participating Member States and by Art. 5 which provides that the EPUE has unitary effect.¹²⁵ The Court interpreted Art. 5 to mean that the unitary effect and extent of protection is defined by the national law of each State, so “the uniformity of the protection conferred by the EPUE stems from the application of Article 5(3) and Article 7 of the contested regulation, which guarantee that *the designated national law* will be applied in the territory of all the participating

¹²⁰ Regulation (EU) 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection.

¹²¹ Agreement on a Unified Patent Court, signed at Brussels on 19 February 2013. OJ 2013/C 175/01.

¹²² C-146/13. CJEU Judgment of 5/05/2015.

¹²³ Preamble of Regulation (EU) No. 1257/2012.

¹²⁴ C-146/13, at para. 33. The other legal challenge concerns the translation arrangements: action C-147/13 in respect of Regulation (EU) 1260/2012 (translation arrangements).

¹²⁵ At paras. 45 and 47.

Member States in which that patent has unitary effect.” [emphasis added]¹²⁶ Yet, this approach arguably overlooks the existing considerable divergence between national courts in the application and interpretation of national laws to the same European patent *post-grant*. A large scale study comparing 9,000 patent suits from seven of the largest countries in the European Union during 2000–2010 shows that judicial outcomes of revocation and infringement proceedings *post-grant* diverge radically across the different countries and types of patented technologies in Europe, making for a complex and uncertain legal environment.¹²⁷ For instance in invalidity challenges to a European Patent granted by the EPO, national courts rejected all invalidity arguments in 50 % of the cases ranging from between 35 % and 38 % in the UK and the Netherlands, respectively, to 42 % in Germany and 56 % in France.¹²⁸ Similarly, litigation outcomes citing lack of an inventive step, varied substantially across jurisdictions, with the upholding of inventive step ranging between 36 % in the Netherlands and 62 % in France.¹²⁹ The study thus underscores the strong variability of national laws at the post-grant stage. In this light, it is unclear how the application of national laws can lead to uniformity and on what basis precisely the UPC will choose the designated applicable national law *post-grant* (alongside the other sources of law including international law, the EPC¹³⁰ and Union law which the UPC requires to apply in its entirety).¹³¹ Furthermore, it is worth noting that under Art. 64(1) EPC, the rights conferred on the patent holder by the EPC are the same as if the patent had been granted in the designated State whilst Art. 64(3) provides that any infringement of a European patent shall be dealt with by national law.¹³² The EPC has been amended to recognize that “Any group of Contracting States, which has provided by a special agreement that a European patent granted for those States has a unitary character throughout their territories, may provide that a European patent may only be granted jointly in respect of all those States”¹³³ whilst granting the EPO additional tasks regarding the grant of the unitary patent.¹³⁴ But there is no counterpart amendment to the scope of protection granted and national infringement route stipulated in Art. 64 raising intriguing questions about the uneasy alignment between the EPC and the “Patent Package” Regulation and Agreement on the substantive material applicable laws to the EPUE *post-grant*.

¹²⁶ At para. 47.

¹²⁷ Graham and Van Zeebroeck (2014).

¹²⁸ *Ibid.*

¹²⁹ *Ibid.*

¹³⁰ Agreement on a Unified Patent Court, signed at Brussels on 19 February 2013. OJ 2013/C 175/01, Art. 24.

¹³¹ Article 20.

¹³² EPC, Art. 64(1) A European patent shall, subject to the provisions of paragraph 2, confer on its proprietor from the date on which the mention of its grant is published in the European Patent Bulletin, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State.

¹³³ Article 141(1) EPC.

¹³⁴ Article 142(2) EPC.

Furthermore, whilst the international Agreement on the Unified Patent Court clearly states that the UPC is competent to interpret the EPC in respect of the EPUE, there is no legal mechanism in the new legal architecture to ensure that the UPC's decisions (or those of the CJEU) will be binding on the EPO. This raises the question of how the so-called uniform and unitary character of the Union's patent can be preserved. The question was raised by Spain in C-146/13.¹³⁵ Spain claimed, *inter alia*, that the grant of a patent by the EPO is an act which cannot be subject to judicial review to ensure the correct and uniform application of European Union law.¹³⁶ As such, and in the absence of a mechanism to facilitate judicial review of EPO acts by the EU court, Spain claimed that the Regulations and Agreement are contrary to the EU Treaties and specifically a violation of the fundamental value of respect for the rule of law in Art. 2 TEU. The UK supported Spain's argument, noting that the Agreement incorporates an international Treaty, the EPC, which does not respect the Constitutional principles of the Treaties.¹³⁷ In his Opinion of 18 November 2014, AG Bot dismissed both arguments, agreeing with the submissions of Belgium, Germany and Sweden instead. In the AG's view, the Regulations and Agreement are not in breach of the rule of law, because they are the result of a lawful legislative process whereby the EU legislature, within the limits of its competences, has vested on the EPO the power to grant the unitary patent. Whilst reliant on the EPC, the Regulation is not intended to incorporate the EPC nor to affect the acts of the EPO regarding the conditions relating to the grant of patents and their validity.¹³⁸ The unitary character of the patent, AG Bot said, relates to the quality of the patent *post-grant*,¹³⁹ after it has been granted and "therefore only attributes to European patents an additional characteristic, namely unitary effect, without affecting the procedure regulated by the EPC, which the EU Member States that are parties to that convention are required to observe."¹⁴⁰ Agreeing with AG's Bot submission, the Court considered that Spain's plea should be rejected since it is intended to contest the legality, in the light of EU law, of the administrative procedure preceding the grant of a European patent.¹⁴¹ In the Court's view, the designation of a European Patent granted by the EPO under EPC rules as a European Patent with unitary protection is an administrative *pro-ante* act of a "strictly accessory nature".¹⁴² The contested regulation is "in no way intended to delimit, even partially, the conditions for granting European patents – which are

¹³⁵ Action C-146/13 in respect of Regulation (EU) 1257/2012 (enhanced cooperation); see this issue of *IIC* at doi:[10.1007/s40319-015-0372-6](https://doi.org/10.1007/s40319-015-0372-6). The other legal challenge concerns the translation arrangements: action C-147/13 in respect of Regulation 1260/2012 (translation arrangements); see this issue of *IIC* at doi:[10.1007/s40319-015-0373-5](https://doi.org/10.1007/s40319-015-0373-5).

¹³⁶ *Ibid.* at para. 21.

¹³⁷ My translation: "Cependant, il considère que, en 'intégrant' dans sa réglementation un système international dans lequel les principes constitutionnels des traités ne sont pas respectés, le règlement attaqué viole les valeurs de respect de l'État de droit." at para. 47.

¹³⁸ *Ibid.* at para. 50.

¹³⁹ *Ibid.* at para. 52.

¹⁴⁰ *Ibid.* at para. 58.

¹⁴¹ *Ibid.* at para. 32 citing para. 61 of AG's Opinion.

¹⁴² *Ibid.* at para. 29.

exclusively governed by the EPC and not by EU law” and therefore it does not “incorporate” the procedure for granting European patents laid down by the EPC into EU law.¹⁴³

It is true that the Regulations and Agreement can be read as affecting only the procedures for enforcement and the substantive applicable law *post-grant*. Indeed, the EPO’s website on the unitary patent stresses precisely this point: “A unitary patent will be a European patent granted by the EPO under the provisions of the European Patent Convention to which unitary effect for the territory of the 25 participating States is given after grant, at the patentee’s request. *The unitary patent will thus not affect the EPO’s day-to-day search, examination and granting work.*”¹⁴⁴ Yet, to do so is also to admit that there is no legal connection between the EPC and the applicable EU/national substantive patent laws *post-grant*, when the whole system assumes that the applicable principles of novelty, inventive-step and industrial application for the grant of a patent on an invention are principles of law which are *common* to all contracting States, and as such are arguably supposed to be aligned at the *pre-grant* and *post-grant* stages.¹⁴⁵ The question thus posed by the latest unification initiative is who is left in control of patent policy in the light of the disconnect in the overarching legal architecture of the newly “rounded-up” European-unified system, as between the EPC based applicable norms by the EPO at the *pre-grant* stage and the EPUE enforcement laws on invalidity and infringement applied by the UPC *post-grant*. The UPC Agreement clearly mandates the UPC to give primacy to and respect Union law (Art. 20). But there is no counterpart requirement on the EPO boards. Could it be that the EU cat is now chasing the EPO tail?

Since the EPC is an international Treaty outside the legal order of the EC/EU, to give legal effect to such a provision would necessitate an amendment to the European Patent Convention in accordance with the rules of the EPC which require a conference of the contracting States to be convened at which no less than three-quarters of the contracting States are represented and voted in favour of the revision.¹⁴⁶ The Community Patent Convention of 1975 had ambitiously sought to establish the ECJ as the final authoritative arbiter on the interpretation of both the Community Patent Convention and the European Patent Convention. But 20 years on, the prospect of the EPC being altered to incorporate judicial scrutiny of EPO acts by the European Union, seems at best remote with the enlargement of the EPO. As of December 2014, the EPO has 38 contracting Member States – that is ten more States than the European Union.¹⁴⁷ There are certainly currently no plans underway to revise the EPC to align the jurisprudence of its boards to that of the CJEU.¹⁴⁸

The problem of aligning patent laws at the grant stage with patent laws at the enforcement stage dates back to the substantive harmonization of patentability

¹⁴³ *Ibid.* at para. 30.

¹⁴⁴ <http://www.epo.org/law-practice/unitary/patent-court.html>.

¹⁴⁵ EPC, Art. 1 “A system of law, common to the Contracting States [2], for the grant of patents for invention is established by this Convention”.

¹⁴⁶ Article 172.

¹⁴⁷ <http://www.epo.org/about-us/organisation/member-states.html>.

¹⁴⁸ According to Frolinger (2014).

requirements effected by the EPC. As was seen at the beginning of this paper, historically, the grant of a patent was an administrative act conducted by examiners skilled in searching prior art to ascertain the novelty of the invention. With the Strasbourg Convention and EPC, the grant process became an act steeped in law in the harmonized patent requirements for an invention which, in addition to novelty, included an inventive-step and industrial application. As an autonomous body with its own Treaty, the EPO through its examining and appeal boards developed its own understanding of patentability requirements building its own *sui-generis* “case law”. But national courts could always revisit the decision of the EPO boards and invalidate a patent granted by the EPO in accordance with national laws. Thus, substantive harmonization of patentability requirements at the pre-grant stage was achieved whilst leaving intact the diversity of national laws at the post-grant, enforcement stage.¹⁴⁹ The enforcement problem which the EU was left to address was, in part, the cost to patent holders of having to defend or prosecute a patent in the different legal systems of Member States where, the lack of uniformity encouraged *forum shopping* and stacked up costs.¹⁵⁰ The creation of a centralized court with exclusive jurisdiction post-grant, applying uniform laws would resolve this problem.¹⁵¹ What it does not do is fill in the gap between the applicable EPC standards/law pre-grant and the applicable law *post-grant*. This, of course, was a problem encountered by national courts under the current national bundle system where national courts were not legally bound to follow the EPO boards interpretation of patentability requirements. What were the implications and risks of national courts at the post-grant stage departing from the EPO’s own understanding of patentability requirements? If national courts developed their own national interpretation of these requirements, the harmonization achieved at the pre-grant stage would be defeated at the post-grant stage. If they followed the EPO’s interpretation instead, this left the EPO effectively in control of patent policy. Who then controlled the EPO? The issues of principle are illustrated in a case heard by the UK Supreme Court in 2011.

¹⁴⁹ Some commentators (e.g. Tilmann, *Community Patent and European Patent Litigation*, (2005) EIPR) claim that the European patent granted by the EPO is not national but international in character and national courts have to apply patentability criteria in a uniform manner. A difficulty with this view is that the patent cannot be enforced until it has morphed into a bundle of national patents, at which point national laws apply. See for instance, Sec. 1 of the UK Patents Act 1977 and Secs. 77 ff. So, the Art. 138 renvoi to Arts. 52–57 on the question of revocation takes us back to the disjunction between EPO (grant) standards and national (post-grant) legal standards. It is difficult to see how – as a matter of international law – and in the absence of other provisions in the EPC mandating uniform application of laws post-grant, Art. 138 could be sufficient to do the trick. It would also mean that the national courts of Member States have consistently misapplied and misinterpreted the EPC.

¹⁵⁰ See Graham and Van Zeebroek (2014) *op. cit.*

¹⁵¹ Although, the shifting of the applicable sources of law from the Regulations to the Agreement for the UPC and the spectrum of applicable laws including national laws does not strictly result in uniform laws beg the question of whether the applicable laws will be uniform – as argued by Spain and notwithstanding A.G. Bot’s Opinion. See Wadlow *op. cit.*

5.2 Case Study

In *Eli Lilly v. HGS*,¹⁵² the UK Supreme Court was asked to determine the “difficult question” of the scope of application of the requirement of industrial application¹⁵³ in a fast moving field of science where “the answer may give rise to potentially far-reaching consequences for scientific research, the biotech industry, and human health.” The patent concerned a gene sequence discovered in 1996 with the use of bioinformatics. The gene sequence encoded a novel protein whose biological function was unknown at the time but was suspected to have an important role to play in the immune system. The patent was granted to HGS by the examining division of the EPO in 2005, notwithstanding the fact that, in the view of Kitchin J., the UK High Court judge who was asked to revoke the patent, the specification “contains extravagant and sometimes contradictory claims”.¹⁵⁴ The patent granted by the EPO examining board was challenged by Eli Lilly in opposition proceedings at the EPO and revocation proceedings in the national courts. In the UK, Kitchin J held the patent failed to meet the industrial applicability requirement under UK law and was therefore invalid:

In this case I am quite satisfied that the skilled person would consider the Patent does not of itself identify any industrial application other than by way of speculation [I]t contains an astonishing range of diseases and conditions The skilled person would consider it totally far-fetched that Neutrokine- α could be used in relation to them all and ... would be driven to the conclusion that the authors had no clear idea what the activities of the protein were and so included every possibility. To have included such a range of applications was no better than to have included none at all.¹⁵⁵

HGS appealed to the Court of Appeal, which upheld Kitchin J.’s decision and to the Supreme Court, which reversed the decision of the Court of Appeal whilst, in the parallel opposition proceedings at the EPO, the patent’s validity was reaffirmed. The UK Supreme Court conducted a detailed review of other jurisdictions and the jurisprudence of the boards of appeal of the EPO. It noted that it was not bound by the decisions of the EPO boards but thought it highly desirable as a matter of principle and practice to align its decisions to those of the EPO, citing Lord Hoffmann in *Conor Medsystems Inc v. Angiotech Pharmaceuticals Inc* [2008] UKHL 49, [2008] RPC 28, para. 3:

A European patent takes effect as a bundle of national patents over which the national courts have jurisdiction. It is therefore inevitable that they will occasionally give inconsistent decisions about the same patent. Sometimes this is because the evidence is different. In most continental jurisdictions, including the [EPO], cross-examination is limited or unknown. Sometimes

¹⁵² [2011] UKSC 51.

¹⁵³ EPC Arts. 52–57.

¹⁵⁴ [2008] RPC 29, para. 134 at 6.

¹⁵⁵ [2008] RPC 29, paras. 231–233, cited at para. 70.

one is dealing with questions of degree over which judges may legitimately differ. Obviousness is often in this category. But when the question is one of principle, it is desirable that so far as possible there should be uniformity EPO boards.

Critically, in deciding to revoke the patent, the UK Supreme Court took account not only of the desirability of aligning its interpretation of the applicable principles to the EPO boards but also of what it called the “wider picture” and policy context.¹⁵⁶ The implications of the ruling in this case, it was claimed, could have a potentially damaging impact on the bio-industry whose association (BIA) had intervened in the case to represent the interests of “hundreds of companies with an aggregate turnover in 2010 of about £5.5bn, and around 36,000 employees.”¹⁵⁷ The Supreme Court was swayed by the BIA’s claim that if the UKSC upheld the Court of Appeal’s ruling it would “make it appreciably harder for patentees to satisfy the requirement of industrial applicability in future cases” and “cause UK bioscience companies great difficulty in attracting investment at an early stage in the research and development process.”¹⁵⁸ Reflecting on these considerations, Lord Hope and Lord Neuberger who were originally inclined to follow Kitchin J. and the Court of Appeal, decided instead that consistency of approach with the EPO boards was preferable.

Evidently, the implications of the so-called “administrative” acts of the EPO at the pre-grant stage can and do, in practice, have far reaching consequences as regards the delineation and scope of the applicable legal principles of patentability and their subsequent effect on invalidity and infringement proceedings *post-grant*. Moreover, the delineation of these principles at the post-grant stage is manifestly critical in encouraging or discouraging economic and industrial policies on innovation including the extension and scope of patent protection to socially and politically sensitive public goods.¹⁵⁹ Yet the legal reality under the latest unification initiative is that the EPO is left outwith judicial scrutiny from the EU Court (and national supreme courts).¹⁶⁰ There is simply no mechanism in the so-called “unified” European Patent system to enable judicial scrutiny of the patent policies of the EPO.

¹⁵⁶ *Op. cit.* 152 at 96.

¹⁵⁷ *Ibid.*

¹⁵⁸ *Ibid.*

¹⁵⁹ For another example of the de-facto dominance of the EPO, see the “case law” of the EPO boards on the interpretation of moral exclusions in the EU Directive on Biotechnological Inventions, incorporated into the EPC via an amendment of the implementing regulations. Plomer “Article 6(2) of the EU Directive on Biotechnological Inventions: Towards Systemic Legal Conflict” in: Plomer and Torremans (2009).

¹⁶⁰ In the words of Hanns Ullrich “Sur le plan législatif, l’Union ne peut ni prendre l’initiative d’une réforme en la matière, aussi opportune qu’elle puisse paraître 111, ni exercer son influence.” Le future système de protection des inventions par brevets dans l’Union européenne: un exemple d’intégration (re-)poussée? Max Planck Discussion Paper No. 2.

6 Conclusion

This paper has argued that the latest EU initiative to effect unification of the European patent system is the outcome of polycentric complex forces to build up a common industrial policy in Europe encompassing States with diverse socio-economic interests and the EU's interaction with external autonomous international organizations. The paper shows that the goal of the patent unification project in Europe has undergone a transformation from the early vague ideals propelled by Council of Europe in 1949, to the adoption of the EPC as a temporary defensive move against transatlantic expansion in Europe pending realization of a fully integrated system to serve the market oriented goals of the European Union. Throughout the 60 decades of the European Union's involvement in the project, integration has proved elusive. Retrospectively, the critical turning point is the creation of the European Patent Organization, an autonomous international organization with a pivotal role in the administration and grant of European patents, yet legally detached from the EU. From thereon, the Union has struggled to formulate a coherent model for integration. The newly "unified" legal structure is a complex and disjointed legal mosaic with only 25 out of 28 EU participating States conferring exclusive jurisdiction on a Court created by an international Agreement whose decisions are not binding on the EPO. At a time when the EU's economic policies and its democratic legitimacy are under unprecedented pressure, the EU patent package looks much like the addition of epicycles to the cycles of times past, building up a fractured and uncertain legal structure on the back of an autonomous organization which is the leading engine for patent policy in Europe but is not itself subject to judicial or meaningful political scrutiny.

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